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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,412	03/25/2004	William T. Walker	4366-148	3274

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EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,412

Applicant(s)

WALKER, WILLIAM T.

Examiner

Jacques H. Louis-Jacques

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/25/04, 4/21/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11, 35-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, the limitation “the license” lacks proper antecedent basis.

In claim 9, line 1, the limitation “a license” lacks antecedent basis. It is not clear whether the “license” recited in claim 1 is the same as “a license” recited in claim 9.

In claim 35, line 13, the limitation “the permissible term” lacks antecedent basis.

In claim 35, line 10, the limitation “the license” lacks clear antecedent basis.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10-11, 33-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10 and 33 merely a “computer readable medium comprising instructions”. The claims fail to recite how these instructions, although stored on a computer readable

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medium, will be performed or executed. The instructions cannot be performed by themselves.

As to claims 11 and 34, the logic circuit (which is a piece of hardware) cannot perform the steps by itself. The logic circuit needs some kind of “program or algorithm” to perform these steps.

Appropriate correction is required.

Claim Objections

5. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Step (c) of claim 1 refers to when the “geographic location is not a permitted geographic location.” However, claim 4 recites a “determining step (c)” in which “the geographic location is a permitted geographic location”. Claim 4 does not further limit claim 1 from which it depends. Appropriate correction is required.

6. Claim 37 is objected to because of the following informalities: Claim 37 refers to “claim 367”. However, there is no “claim 367” in the application. Furthermore, a claim can depend only from a “preceding claim” (37 CFR 1.75). It appears that the reference of “claim 367” in claim 37 is a typographical error. The dependency of claim 37 is taken to be from “claim 36”. Appropriate correction is required.

7. Claims 8, 9, 30, 35, 43 and 44 are objected to because of the following informalities: In claim 8 (line 3, after “device;”), claim 9 (line 3, after “component;”), claim 30 (line 2, after

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“device;”),. Claim 35 (line 11, after “license;”), claim 43 (line 3, after “device;”) and claim 44 (line 3, after “component;”), Applicant is suggested to added the word “and”. Appropriate correction is required.

Information Disclosure Statement

8. The Information Disclosure Statements filed on March 25, 2004 and April 21, 2005 have been considered by the examiners. Items 12-17 of March 25, 2004, which are US patent applications, have been crossed out replaced by their corresponding US Patent Application Publication numbers in the attached PTO form 892.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Wall [US 2002/0017977].

Wall discloses a method and apparatus for licensing and controlling access, use, and viability of product (e.g., computational component) utilizing geographical (e.g., GPS) position. According to Wall, there is provided whether an intended use of a computational component (e.g., 103, [0084] is permitted by (a) determining a geographic

location (such as by a GPS device or module) of at least one of the computational component and a key device in communication with the computational component [0030], (b) comparing the geographic location (such as with a validation agent like a processor) with at least one predetermined geographic location permitted by the license [0031], and (c) when the geographic location is not a permitted geographic location under the license, determining that use of the computational component is not permitted [0030]. According to Wall, (d) when the geographic location is a permitted geographic location under the license, determining that use of the computational component is permitted [0030]. See also paragraphs [00887]-[0088]. According also to Wall, the step of determining a geographic location comprises the steps of determining GPS coordinates of the at least one of the computational component and key device and converting the GPS coordinates into a region identifier, wherein the permitted geographic location is one or more region identifiers and wherein [in the determining step (c)] the geographic location is a permitted geographic location when the region identifier identified in the converting step is included in the one or more region identifiers [0096]-[0097]. According to Wall, the at least one of the computational component and a key device is the computational component or the key device. See figures 1 and 3. The permitted use is defined by a license, according to Wall, and method of determining permitted use further comprises the steps of determining whether the key device is in communication with the computational component, (e) when the key device is not in communication with the computational component, determining that the computational component is not validly licensed; and (f) when the key device is in communication with the computational

component, determining that the computational component is validly licensed. See figure 5 and paragraphs [0107] and [0136]-[0140]. In addition, Wall discloses (d) authenticating the key device and when the key device is not authenticated successfully, determining that the computational component is not validly licensed. See page 10. As described on page 7 ([0101], [0105]), Wall discloses a computer readable medium comprising instructions, when executed by a computer (e.g., processor 103) causing the computer to perform the aforementioned steps. Wall discloses a logic circuit (e.g. processor or computer) operable to perform the aforementioned steps. Additionally, Wall discloses receiving Global Positioning System (GPS) information from a GPS receiver [0030], the GPS information comprising at least one of a geographic location and a clock setting [0030], [0038], [0091]-[0094], wherein the geographic location is associated with the location of at least one of the computational component and a key device in communication with the computational component. Wall also discloses comparing the geographic location with at least one predetermined geographic location permitted by the license; and comparing the clock setting with an expiration date of the license. According to Wall, when the geographic location is not a permitted geographic location under the license and/or when the clock setting is outside of the permissible term of the license, determining that use of the computational component is not permitted. See paragraphs [0090]-[0094], [0101]-[0105].

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,790,074	Rangedahl et al	Aug. 1998
6,011,973	Valentine et al	Jan. 2000
6,765,492	Harris	Jul. 2004
6,778,820	Tendler	Aug. 2004
US 2002/0125886	Bates et al	Sep. 2002
US 2002/0154777	Candelore	Oct. 2002
US 2004/0166878	Erskine et al	Aug. 2004
US 2005/0202830	Sudit	Sep. 2005
US 2005/0246098	Bergstrom et al	Nov. 2005

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is 571-272-6962. The examiner can normally be reached on M-Th 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacques H Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER